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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/809,584
Filing Date: March 25, 2004
Appellant(s): CHILDRESS ET AL.

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Technology Center 2100

Peter Manzo, Reg. No. 54,700
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/11/07 appealing from the Office action mailed 11/13/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Art Unit: 2113

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 03/098449 A1

HOLT et al.

11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The disclosure contains intrinsic evidence that the article of manufacture (i.e. the claimed computer program product) is intended to cover transmission links, light waves, radio frequency transmission, etc. (see Specification page 16 line 28-page 17 line 4). The claims therefore fail to fall within a statutory category. Light waves, radio frequency transmissions, etc. are merely forms of energy and are not a machine, process, manufacture or composition of matter. In addition, such computer readable media is not structurally and functionally

interconnected with the software in such a manner to enable any usefulness to be realized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-20 rejected under 35 U.S.C. 102(a) as being anticipated by Holt et al. (WO 03/098449 A1).

Regarding claim 1:

Holt teaches:

a plurality of notification units (paragraph 0017 lines 5-7);

a network coupled to said plurality of notification units, said network operable to determine whether each notification unit of said plurality of notification units is available to receive system management information (Fig. 1 and paragraph 0030); and

a plurality of management units coupled to said network (Fig. 3), at least one management unit of said plurality of management units configured to perform the steps:

generate said system management information (paragraph 0017 lines 1-3);

determine an identity of an intended recipient for said system management information (paragraph 0024 lines 10-12);

associate said identity with at least one notification unit of said plurality of notification units (paragraph 0017 lines 5-7 and paragraph 0030 lines 5-8); determine whether said at least one notification unit is available to receive said system management information (paragraph 0030); and send said system management information to said at least one notification unit via a notification handler if said at least one notification unit is available to receive said system management information (paragraph 0017).

Regarding claim 2:

Holt teaches:

wherein said notification handler converts said system management information into a form that is appropriate for the notification unit (paragraphs 0030-0033 – the notification can be sent in any format (i.e. instant message, email, etc.) depending on the appropriate format for the notification unit the message is sent to).

Regarding claim 3:

Holt teaches:

wherein said network comprises a presence network (paragraph 0015).

Regarding claim 4:

Holt teaches:

wherein said network comprises an instant messaging network (paragraph 0030).

Regarding claim 5:

Holt teaches:

wherein said at least one notification unit comprises an instant messaging client associated with said intended recipient (paragraph 0030).

Regarding claim 6:

Holt teaches:

wherein said at least one management unit comprises at least one of a management agent and a managed resource (Fig. 3 – the various servers are clearly equivalent to management agents or managed resources).

Regarding claim 7:

Holt teaches:

wherein said system management information comprises event information or notification information (paragraph 0017 lines 3-5).

Regarding claim 8:

Holt teaches:

Art Unit: 2113

wherein said intended recipient comprises at least one of an entity, party and person having a responsibility for responding to said system management information (paragraphs 0004 and 0017).

Regarding claim 9:

Holt teaches:

wherein the operation to determine said identity comprises an operation to access an on-call list of responsible entities, parties or persons (paragraph 0024).

Regarding claims 10-18:

The claims are rejected as the methods of using the systems of claims 1-9.

Regarding claims 19-20:

The claims are rejected as the program products causing the methods of claims 10-11 to be performed.

(10) Response to Argument

Applicant argues, on pages 10-12 :

"No basis exists for holding a computer program product claim as non-statutory because the computer readable medium may be allegedly intangible....Thus, the transmission-type media, or carrier waves and signals, are "tangible" despite the

Art Unit: 2113

allegation made in the Final Office Action to the contrary. Consequently, even if there were some MPEP requirement that the media be "tangible," which there is not, claim 19, as recited, would still meet that requirement."

The examiner respectfully disagrees. The computer readable medium of the claim is intended to cover transmission type media such as, for example, light waves or radio frequency transmissions. These forms of transmission type media are nothing more than forms of energy and thus do not fall into one of the four statutory categories of patentable subject matter. Further, these types of media do not contain the structural and functional interrelationship with the instructions necessary to allow the functionality and usefulness of the instructions to be realized.

Applicant argues, on pages 12-16 :

"The specification teaches that the system management information is data regarding the occurrence of an event, such as a critical failure of a system component or notification relating to a critical failure of a system component....In other words, a problem that Appellants were endeavoring to solve at the time of invention was the efficient dissemination of system management information with regard to the critical failure of system components....Holt does not teach generating and sending "system management information" as recited in claim 1."

Art Unit: 2113

The examiner respectfully disagrees. As was previously explained in two interviews and the Final Rejection, system management information is clearly defined in applicant's specification to include notification or event information (Specification page 5, lines 21-24). The notification message of Holt clearly meets this definition of system management information.

Applicant appears to believe that system management information should be limited to information concerning a critical failure of a system component. Such a limitation, however, does not ever appear in the claims. If applicant would like such a limitation considered, the examiner suggests adding such a limitation to the language of the claims. It would appear clear that applicant intends to gain coverage for the broad interpretation of system management information due to the fact that applicant has not explicitly defined the term as covering only information regarding critical failures of system components and has instead included, by way of example, "notification information, etc." in the description of system management information cited by both the examiner and applicant in applicant's own arguments. The claims, as currently written, would clearly give applicant coverage for, not only critical failure information as applicant suggests, but also for any type of information that falls under the broad scope of event information or notification information and are thus properly rejected by the notification information contained in Holt.

To the extent that applicant's specification provides a guiding definition for the broadest reasonable interpretation of the term "system management information," the cited page and lines of the specification are the only proper guidance, i.e. notification or

Art Unit: 2113

event information. The fact that applicant later mentions that such notification or event information could possibly include things such as critical failure information (see Specification page 14, line 23-page 15, line 5 – also cited in applicant's arguments in the appeal brief) does nothing to explicitly define the term as being limited to such critical failure information. In fact, in applicant's own citations from the argument in the appeal brief, notification information is again given as an example of system management information. This is entirely contrary to applicant's argument that notification information, such as that clearly and explicitly taught by Holt and relied upon in the rejection, is not system management information.

Further, the problem that applicant is endeavoring to solve does not define terms used in the claim language. Again, if applicant would like to limit system management information to only information concerning critical failures of system components, the examiner suggests such language be added to the claims.

Applicant argues, on pages 16-18 :

"Holt does not teach that the present and available user has a "responsibility for responding" to the incoming message. In contrast, claim 8 recites that the intended recipient of the system management information has a "responsibility for responding" to the system management information....Holt makes no reference to a duty or obligation by a present and available online user to respond to an incoming message."

The examiner respectfully disagrees. The responsibility to respond does not require that a response be made. The claims do not teach a response being made. The responsibility to respond merely means that, if a response were to be made, the recipient of the system management information would be the responder. Whether or not a response is or is not made has no bearing on the responsibility to respond. As an example, if a supervisor were to send a message to an employee instructing said employee to call him regarding a work assignment and the employee neglects to do so, the employee has not responded to the message, but that does not change the fact that the employee is held responsible for responding.

With regard to the Holt reference, it is clearly taught that a recipient of the message (system management information) has registered with the system in order to be notified when a user of interested has become available for communication. It can thus clearly be seen that the user having registered to receive the notification message (system management information) would be the user that would be expected to respond to such notification message, were a response to be made. It is thus necessarily true that the user in question has the responsibility to respond to the message, whether or not a response ever occurs. The latter portion, however, is not included in any claim limitations and, thus, the question of whether or not Holt teaches actually responding is a moot point.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Marc Duncan



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